

REMARKS

Claims 1-19 are pending in the application.

Claims 1-3, 5 7-11, 13-14, 16 and 18 were amended herein; claims 19-20 were added.

Claims 1-20 are now pending.

Reconsideration of the claims is respectfully requested.

35 U.S.C. § 103 (Obviousness)

Claims 1-10 and 12-18 were rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,546,058 to *Gilhousen et al* in view of U.S. Patent No. 6,574,266 to *Haartsen et al*. Claim 11 was rejected under 35 U.S.C. 103(a) as being unpatentable over *Gilhousen* in view of *Haartsen* and further in view of U.S. Patent Application Publication No. 2003/0144003 to *Ranta et al*. These rejections are respectfully traversed.

In *ex parte* examination of patent applications, the Patent Office bears the burden of establishing a *prima facie* case of obviousness. MPEP § 2142; *In re Fritch*, 972 F.2d 1260, 1262, 23 U.S.P.Q.2d 1780, 1783 (Fed. Cir. 1992). The initial burden of establishing a *prima facie* basis to deny patentability to a claimed invention is always upon the Patent Office. MPEP § 2142; *In re Oetiker*, 977 F.2d 1443, 1445, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992); *In re Piasecki*, 745 F.2d 1468, 1472, 223 U.S.P.Q. 785, 788 (Fed. Cir. 1984). Only when a *prima facie* case of obviousness is established does the burden shift to the applicant to produce evidence of nonobviousness. MPEP § 2142; *In re Oetiker*, 977 F.2d 1443, 1445, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992); *In re Rijckaert*, 9 F.3d 1531, 1532, 28 U.S.P.Q.2d 1955, 1956 (Fed. Cir. 1993). If the Patent Office does not produce a *prima facie* case of unpatentability, then without more the applicant is entitled to grant of a patent. *In re Oetiker*, 977 F.2d 1443, 1445, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992); *In re Grabiak*, 769 F.2d 729, 733, 226 U.S.P.Q. 870, 873 (Fed. Cir. 1985).

A *prima facie* case of obviousness is established when the teachings of the prior art itself suggest the claimed subject matter to a person of ordinary skill in the art. *In re Bell*, 991 F.2d 781, 783, 26 U.S.P.Q.2d 1529, 1531 (Fed. Cir. 1993). To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed invention and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. MPEP § 2142. In making a rejection, the examiner is expected to make the factual determinations set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 17, 148 USPQ 459, 467 (1966), *viz.*, (1) the scope and content of the prior art; (2) the differences between the prior art and the claims at issue; and (3) the level of ordinary skill in the art. In addition to these factual determinations, the examiner must also provide “some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.” (*In re Kahn*, 441 F.3d 977, 988, 78 USPQ2d 1329, 1336 (Fed. Cir 2006) (cited with approval in *KSR Int’l v. Teleflex Inc.*, 127 S. Ct. 1727, 1741, 82 USPQ2d 1385, 1396 (2007)).

The Applicant respectfully disagrees and traverses the §103 rejections. The Applicant directs the Examiner’s attention to independent Claim 1, which recites the unique and novel limitations, some of which are emphasized below:

1. A method to be performed by a UE (user equipment), comprising:
detecting downlink signals of an active cell in which said UE is camping
and its adjacent cells;
*judging whether there exists a suitable cell whose link performance is a
predefined value higher than that of said active cell, according to the detecting
result;*

sending a detection report message to a network system to start a judging procedure of said network system if there exists said suitable cell, and said judging procedure deciding whether said UE and another UE in P2P communication can handover into said suitable cell to continue P2P communication.

Claim 1 comprises the element, "deciding whether said UE and another UE in *P2P communication* can handover into said suitable cell to continue *P2P communication*." [Emphasis Added] This element is not taught, suggested, or anticipated by the prior art of record. In P2P communication mode, signaling signal takes place between the UE and the network system, while traffic signals are flowing between two P2P communicating UEs. The use of a UE to perform the steps disclosed in Claim 1 during a P2P communication session is respectfully submitted not to be taught, suggested, or anticipated by the prior art of record.

The Office Action concedes that Gilhousen does not disclose P2P communication (Office Action, pg. 2, ll. 16-17) and attempts to cure this deficiency through Haartsen, citing the Abstract of Haartsen and Col. 12 ll. 28-49 of Haartsen. For ease of reference, the cited sections of Haartsen cited in the Office Action is set forth below:

A system and method for establishing *ad hoc* communication sessions between remote communication terminals is disclosed. A base station transmits a beacon signal including information about the identity and system clock of the base station. *Remote terminals within range lock to the base station, synchronizing their system clocks with the base station's clock and setting their hop sequence and hop sequence phase based on information in the beacon signal. To establish an ad hoc communication session, a master terminal first establishes a link to the base station, which establishes a link to a desired slave terminal. The base terminal exchanges information between remote terminals that enables the master terminal to establish a direct communication session with a slave terminal.* [Abstract of Haartsen, Emphasis Added]

One of the advantages of *having the terminals stay locked to the base station* arises when, for example, the quality of the link 283 deteriorates to a point where excessive errors occur in the communication. *Either or both terminals 240, 250 can then easily and quickly send a message to the base station 210 requesting allocation of another channel or hop sequence. In addition, if one or both terminals move into an area or areas covered by a different base station 211 (see*

FIG. 7D), the terminals can request a "handover" of control from the base station 210 to the other base station 211. In that case, the base station 210 would send a message to the new base station(s), informing the new base station(s) that terminals 240, 250 having an ongoing ad hoc connection have roamed into the area or areas covered by the new base station(s). The base station 210 or the new base station 211 would also send messages to the terminals 240, 250, directing them to listen to the broadcast channel(s) of the new base station(s). A new base station 211 takes over control when the terminals 240, 250 listen to the broadcast channel of the new base station instead of the broadcast channel 280 of the base station 210. As a result of such a handover, the channel 283 may be changed, e.g., to minimize interference, etc. [Col. 12 ll. 28-49 of Haartsen, Emphasis Added]

The sections of Haartsen cited in the Office Action do not establish that Haartsen uses P2P communications. Ad hoc communication is not the same as P2P communications. As previously discussed, in P2P communication mode, signaling takes place between the UE and the network system, while traffic signals are flowing between two P2P communicating UEs.

In ad hoc communications, a master/slave relationship is created. This master/slave relationship requires that a master first must be determined and the subsequent communication may follow. In P2P relationships, there is no need for a master, as both UEs are peers. Therefore the method by which communication is established using a P2P framework is not the same as the Master/Slave ad hoc relationship disclosed by Haartsen. The use of the P2P framework allows for signaling to takes place between the UE and the network system, while traffic signals to flow between two P2P communicating UEs. In contrast, in the system of Haartsen, a master/slave relationship must first be established to create the channel for traffic signals to flow over. The P2P framework disclosed is not anticipated, taught, or suggested by the prior art of record.

In addition, Claim 1 comprises the element of *"judging whether there exists a suitable cell whose link performance is a predefined value higher than that of said active cell."* The judging of Claim is initiated by *"sending a detection report message to a network system."* The Examiner has attempted to cite Gilhousen as teaching the element. However, as the Examiner

has already acknowledge that Gilhousen does not teach P2P communication, Applicants respectfully submit that Gilhousen cannot teach, suggest, or anticipate the use of a judging procedure to determine the cell quality for P2P communications. The judging of a suitable cell for P2P communications requires, as noted by paragraph [0029] of the specification, the simultaneous handoff of at least two UE devices. Part of this paragraph from the specification of the present application is reproduced below:

Considering whether to handover the two UEs to another cell simultaneously and continue P2P communication, or maintain the P2P communication between the two UEs in current active cell, or handover the two UEs into conventional mode so that their communication won't be broken down, handover in P2P communication mode shows difference from the above handover in conventional communication mode. [Paragraph [0029], Specification as filed].

Therefore, the judging of Claim 1, which determines if handover operations may be preformed for at least two UE devices at nearly or exactly the same time, is therefore not taught, suggested, or anticipated by Gilhousen.

Independent Claims 7 and 14 also recite limitations analogous to the novel limitations emphasized above in traversing the rejection of Claim 1 and, therefore, also is patentable over the combination of cited references. Therefore, the Applicants respectfully submit that independent Claims 1, 7 and 14 are patentable over the cited references.

With respect to the rejection of dependent Claims 2-6, 8-13, and 15-18 over Haartsen and Gilhousen, for the same or similar reasons set forth above, and because the cited portions of Gilhousen fails to cure the noted deficiency in Haartsenm, these claims are also patentable.

With respect to the rejection of dependent Claim 11 over Gilhousen, Haartsenm and Ranta et al. (US 2003/0144003) for the same or similar reasons set forth above, and because the cited portion of Ranta et al. fails to cure the noted deficiency in the prior art., this claims is also patentable.

Accordingly, the rejection of claims 1-18 under 35 U.S.C. § 103 has been overcome.

If any issues arise, or if the Examiner has any suggestions for expediting allowance of this Application, the Applicant respectfully invites the Examiner to contact the undersigned at the telephone number indicated below or at *dvenglarik@munckcarter.com*.

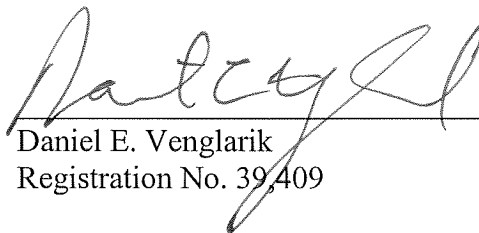
The Commissioner is hereby authorized to charge any additional fees connected with this communication or credit any overpayment to Deposit Account No. 50-0208.

Respectfully submitted,

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